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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,169	08/21/2003	Atsushi Nakajima	03486/HG	1783

1933 7590 03/11/2005

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EXAMINER	
KLEMANSKI, HELENE G	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,169	NAKAJIMA ET AL.	
	Examiner	Art Unit	
	Helene Klemanski	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-14 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 21 August 2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/17/03&~~3/4/04~~
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6-8, 11-13 and 17 are of copending Application No. 10/647,170 (US 2004/0052967). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9 and 10 of copending Application No. 10/853,897 (US 2004/0241578). Although the conflicting claims are not identical, they are not patentably distinct from each other because the

claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9, 10 and 12 of copending Application No. 10/826,059 (US 2004/0244641). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-11, 13 and 14 of copending Application No. 10/861,572 (US 2004/0252171). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-10 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2,

4, 5 and 8 of copending Application No. 10/648,579 (US 2004/0052968). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

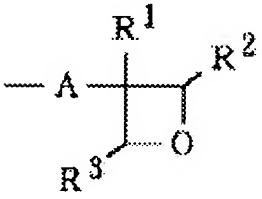
Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP2000256571.

JP2000256571 teach a thermosetting resin composition comprising an oxetane ring containing compound of the formula



wherein R^1, R^2 and R^3 independently are H or a straight-chain or branched C_{1-18} alkyl group and A is a divalent hydrocarbon group which may contain an O atom in the main chain (i.e. substituted in the 2-position), a cross-linking agent and a curing catalyst. The

thermosetting resin composition is useful for producing ink compositions. See the abstract and the compound (I). The thermosetting resin composition useful fro producing ink compositions as taught by JP2000256571 appears to anticipate the present claims.

The preamble limitation "for ink-jet recording" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 6411.

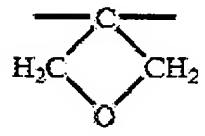
Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-3, 5, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizaki et al. (2003/0158286).

Nishizaki et al. teach an active energy beam-curable composition comprising an epoxy compound, an oxetane compound of the formula



such as 2-ethylhexyl (3-ethyl-3-oxetanylmethyl) ether, 2-tetrabromophenoxyethyl (3-ethyl-3-oxetanylmethyl) ether, 2-tribromophenoxyethyl (3-ethyl-3-oxetanylmethyl) ether,

2-hydroxyethyl (3-ethyl-3-oxetanylmethyl) ether, 2-hydroxypropyl (3-ethyl-3-oxetanylmethyl) ether or 1,2-bis[(3-ethyl-3-oxetanylmethoxy) methyl] ethane, a photo-cationic polymerization initiator such as an onium salt, a pigment and a pigment dispersing agent. See para. 0008, paras. 0017-0022, paras. 0024-0026 and claims 1 and 5. Nishizaki et al. fail to specifically exemplify the use of an oxetane compound having a substituent in the 2-position as claimed by applicants.

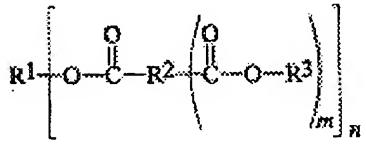
Therefore, it would have been obvious to one having ordinary skill in the art to use the specific oxetane compound having a substituent in the 2-position as claimed by applicants as Nishizaki et al. also discloses the use of these oxetane compounds but fails to show an example incorporating them.

The preamble limitation "for ink-jet recording" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 6411.

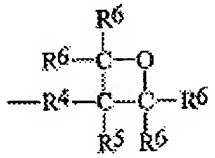
Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

11. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/36660.

WO 02/36660 teach an oxetane compound of the formula



wherein m is an integer of at least 1; n is an integer of at least 2; R^1 is a group derived from a di, tri or polyhydric compound; R^2 is alkyl, aryl, alkylaryl or arylalkyl; R^3 is a group of the formula



wherein R^4 is alkyl, alkyloxyalkyl, alkylaryl, aryl, arylalkyl or aryloxyalkyl; R^5 is H, alkyl, alkoxy, aryl or aryloxy; and each R^6 is independently H, alkyl, alkyloxyalkyl, alkylaryl, aryl, arylalkyl or aryloxyalkyl with the proviso that at least one of said alkyl, alkoxy or aryl has at least one carbon atom being hydroxyl substituted. WO 02/36660 further teaches that the oxetane compound may be used in ink compositions. See page 1, lines 10-13, page 2, line 34 – page 3, line 10 and claim 1. WO 02/36660 fails to specifically exemplify the use of the oxetane compound in an ink composition as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific oxetane compound in an ink composition as claimed by applicants as WO 02/36660 also discloses the use of these oxetane compounds in ink compositions but fails to show an example incorporating them.

The preamble limitation "for ink-jet recording" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 6411.

Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helene Klemanski
Primary Examiner
Art Unit 1755

HK
March 7, 2005